

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)
Bryan) Patent Pending
Serial No.: **09/871,349**) Examiner: Mr. Vishu K. Mendiratta
Filed: **May 31, 2001**) Group Art Unit: 3711
For: **Game Board and Game Having a Touring**) Confirmation No.: 9565
Band Theme)
Attorney's Docket No: **4822-001**

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October 2, 2006
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SUPPLEMENTAL REPLY BRIEF

This follows the Second Remand in this case. In the Second Remand of June 29, 2006, the Board has remanded the case to the Examiner to consider the Rule 132 Declaration submitted by Mr. Paul Bryan. Secondly, the Board has remanded the application to the Examiner to properly identify all of the art relied upon in rejecting the claims, to restate the rejection identifying which art is applied to which claim, and to respond to Appellant's arguments.

First the Board is referred to Appellant's first Reply Brief dated August 11, 2005. The arguments and evidence referred to therein are expressly incorporated herein by reference.

I. The Examiner Still Does Not Rebut the Testimony of Mr. Bryan

At page 9 of the Examiner's Supplemental Answer, there are two sentences devoted to Mr. Bryan's Rule 132 Declaration. They are as follows:

The Declaration under 37 CFR 1.132 filed 3/28/05 is insufficient to overcome the rejection of claims 1-11 and 13-15 based upon 35 USC 103(a) as set forth in the last Office action because: Examiner is allowed to interpret "challenge, rescue or band equipment cards" as broadly and reasonably as possible. What applicant refers to as "functionality" of cards is only intended use of the indicia on cards. The indicia on Elrod cards can be used to form groups of cards and printed matter in those cards can be used for intended purpose to play a game.

Examiner's Supplemental Answer, p. 9.

The issue here is not one of claim construction or "intended use." The Examiner never addresses the test for the printed matter doctrine or Mr. Bryan's testimony. Clearly, as this Board stated in its first Remand, the test is whether the printed matter is functionally related to the underlying object or substrate. This issue has nothing to do with interpreting "challenge, rescue or band equipment cards" as broadly and as reasonably as possible.¹ The Examiner's argument with respect to intended use is irrelevant. Again, the question is whether there is a functional relationship between the claimed printed matter and the underlying substrate. Even if the printed matter relates to intended to use, that does not answer the question of whether the printed matter relates to the substrate. As shown above, the Examiner argues that the indicia on the Elrod cards can be used to form groups of cards and printed matter in those cards can be used for intended purposes to play a game. This does not address the printed matter issue or the testimony of Mr. Bryan. The question revolves around the Applicant's claimed invention - not what Elrod discloses.

¹ This is not the test for claim construction. There is a difference between "the broadest reasonable interpretation" and "as broadly and as reasonably as possible."

Importantly, Mr. Bryan's testimony establishes that there is a functional relationship between the printed matter and the substrate. Nowhere does the Examiner even attempt to rebut the factual assertions of Mr. Bryan. Without any rebuttal of Mr. Bryan's testimony and without any relevant argument as to why Mr. Bryan's testimony is not competent, or why it should be totally disregarded, it follows that Mr. Bryan's testimony is the only evidence before the Board concerning the relationship between the printed matter and the substrate. It should be accepted as the truth.

II. The Examiner's Answer Still Does Not Respond to Appellant's Arguments Directed to Each Group of Claims

The Examiner's Supplemental Answer does not differ substantially from the first Answer. In the Remand, the Board states that the Examiner's Answer "does not restate the rejection of the claims and does not respond to Appellant's arguments directed to each of the group of claims. Based on Appellant's review of the Supplemental Answer, it does not appear that the Examiner has truly responded to Appellant's arguments with respect to the various groups of claims.

Conclusion

Applicant's arguments as to patentability stand unrebutted. The Examiner never correctly addresses the printed matter doctrine. Not once does the Examiner even maintain that the claimed printed matter is not related to the substrate. The Examiner does not rebut one factual statement found in Mr. Bryan's Declaration. Still, the Examiner mixes legal authority with the prior art in the articulation of the basis of the obviousness rejections. This is legal error. For the reasons set forth above, it is respectfully urged that all claims in the present application are patentable and the Board is respectfully urged to reverse the Examiner's rejections on all claims.

Respectfully submitted,

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